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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,754	04/09/2001	Chung-Wei Wu	DEE-PT016	6486
3624	7590	06/09/2004	EXAMINER	
VOLPE AND KOENIG, P.C. UNITED PLAZA, SUITE 1600 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103			DEAN, RAYMOND S	
			ART UNIT	PAPER NUMBER
			2684	4

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,754

Applicant(s)

WU, CHUNG-WEI

Examiner

Raymond S Dean

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 - 8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 3, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Pecen et al. (US 6,466,804 B1).

Regarding Claim 1, Pecen teaches a mobile phone configured to be contactlessly activated by a signal transmitted from an activation device outside said mobile phone (Figure 2, Column 3 lines 46 – 56, the activation device is the server device (200), 206 is a mobile subscriber unit, a mobile phone is a mobile subscriber unit, the invention of Pecen eliminates the need for the mobile units to have SIM cards thus said mobile units are activated wirelessly by a remote SIM card), comprising: an integrated circuit (IC) card driver connected with a communication system for communicating with others (Figure 2, Column 3 lines 46 – 56, since the mobile subscriber unit (206) can communicate with others wirelessly and since said mobile subscriber unit (206) comprises integrated circuits that enables said mobile subscriber unit (206) to communicate with others wirelessly there is an inherent integrated circuit

card driver); and an access module connected with said IC card driver and said communication system for receiving said signal transmitted from said activation device to activate said mobile phone, thereby communicating with said others (Figure 2, Column 3 lines 46 – 56, the mobile subscriber unit (206) can access the remote SIM wirelessly thus there is also an inherent access module, upon access of said remote SIM said mobile subscriber unit (206) will be activated).

Regarding Claim 2, Pecan teaches all of the claimed limitations recited in Claim 1. Pecan further teaches wherein said activation device comprises an IC card and a transmitter (Figure 3A, SIM card (202) is the IC card, local link transceiver (230) is the transmitter).

Regarding Claim 3, Pecan teaches all of the claimed limitations recited in Claim 2. Pecan further teaches wherein said IC card records an identification data for being recognized by said access module (Column 3 lines 46 – 56, a SIM card inherently has identification data stored on said SIM card).

Regarding Claim 8, Pecan teaches all of the claimed limitations recited in Claim 1. Pecan further teaches an access module that detects said signal transmitted from said activation device and said IC card driver activates said communication system (Column 3 lines 46 – 56, the mobile units will be activated to communicate wirelessly upon accessing the remote SIM card).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pecan et al. (US 6,466,804 B1) in view of Peters (US 6,601,093 B1).

Regarding Claim 4, Pecan teaches all of the claimed limitations recited in Claim

2. Pecan further teaches a signal that is transmitted from said activation device to activate said communication system to get communication with said others (Column 3 lines 46 – 56, the mobile units will be activated to communicate wirelessly upon accessing the remote SIM card).

Pecan does not specifically teach automatically detecting the distance between said activation device and said mobile phone when said activation device approaches said mobile phone in a specific.

Peters teaches automatically detecting the distance between a wireless device and a mobile phone when said wireless device approaches said mobile phone in a specific distance (Column 6 lines 44 – 67, in order for the presence of a Bluetooth enabled device to be detected the distance has to be detected thus an inherent distance detection is taught).

Pecen (Column 3 lines 30 – 33) and Peters both teach wireless devices that establish wireless bi-directional links via a Bluetooth protocol thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Bluetooth link taught in Peters as the local wireless link in Pecen for the purpose providing communication means to roaming mobile users.

Regarding Claim 5, Pecen teaches all of the claimed limitations recited in Claim 1. Pecen further teaches an activation device that is carried on a user and said communication system is activated by said activation device (Column 3 lines 39 – 42, Column 3 lines 46 – 56, the server device is a mobile unit thus it can be carried on a user, the mobile units will be activated to communicate wirelessly upon accessing the remote SIM card).

Pecen does not specifically teach the method of activating the communication system when said activation device approaches a specific distance from said mobile phone.

Peters teaches the method of establishing a wireless link between a wireless device and a mobile phone when said wireless device approaches a specific distance from said mobile phone (Column 6 lines 44 – 67).

Pecen (Column 3 lines 30 – 33) and Peters both teach wireless devices that establish wireless bi-directional links via a Bluetooth protocol thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Bluetooth link taught in Peters as the local wireless link in Pecen for the purpose providing communication means to roaming mobile users.

5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pecen et al. (US 6,466,804 B1) in view of Peters (US 6,601,093 B1) and in further view of Kennedy et al. (US 6,377,825 B1).

Regarding Claim 6, Pecen in view of Peters teaches all of the claimed limitations recited in Claim 5. Pecen in view of Peters does not specifically teach a mobile phone that is used in a vehicle.

Kennedy teaches a mobile phone that is used in a vehicle (Abstract, Figure 1A, Column 5 lines 8 – 25).

Pecen in view of Peters and Kennedy teach mobile subscriber units that establish wireless bi-directional links via a Bluetooth protocol thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the hands free device taught in Kennedy in the wireless system of Pecen in view of Peters for the purpose of enabling a user to operate the mobile subscriber unit hands free in a vehicle.

Regarding Claim 7, Pecen in view of Peters and in further view of Kennedy teaches all of the claimed limitations recited in Claim 6. Kennedy further teaches a mobile phone that is combined with an audio system in said vehicle (Figure 3, Figure 4A, Column 10 lines 34 – 57).

Response to Arguments

6. Examiner acknowledges the amendment to the Specification to eliminate the informalities thus the objection to said Specification is withdrawn.

Examiner acknowledges amendment to the drawings with the designated legend --Prior Art—thus the objection to said drawings is withdrawn.

Examiner respectfully disagrees with Applicant's assertion that Pecen does not teach or suggest that a mobile phone without a SIM card can be contactlessly activated by a signal transmitted from an activation device outside the mobile phone. Please refer to Figure 2, Column 3 lines 46 – 56 in Pecen. The invention of Pecen eliminates the need for the mobile units to have SIM cards because said mobile units can wirelessly access the SIM card on the server device (200) for the purpose of activating said mobile units, thus said mobile units can be "contactlessly" activated by said server device (200).

Examiner respectfully disagrees with Applicant's assertion that Pecen does not teach or suggest an access module and an IC card driver. Please refer to Column 3 lines 46 – 56. The invention of Pecen comprises a mobile subscriber unit (206) that inherently comprises integrated circuit cards that enable said mobile subscriber unit to communicate wirelessly with others. Since said mobile subscriber unit inherently comprises integrated circuit cards there is also an inherent integrated circuit card driver. The mobile subscriber unit wirelessly accesses the SIM card on the server device (200) such that said mobile subscriber unit can be properly activated thus there is an inherent access module in said mobile subscriber unit.

Applicant stated in the Declaration that foreign priority is not claimed, furthermore Applicant did not file this application (09828754) in the United States within 12 months of filing in Taiwan thus the effective filing date of said application is April 9, 2001.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Raymond S. Dean at telephone number (703) 305-8998.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung, can be reached at (703) 308-7745. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

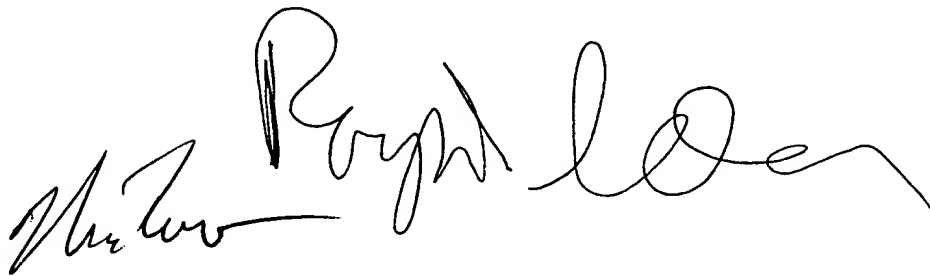
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Or faxed to:

(703) 872-9314 (for Technology center 2600 only)

Hand – delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377

A handwritten signature in black ink, appearing to read "Nick Corsaro", written in a cursive style.

NICK CORSARO
PATENT EXAMINER